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STOUT, UXA, BUYAN & MULLINS LLP
4 VENTURE, SUITE 300
IRVINE CA 92618

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AUG 27 2004

OFFICE OF PETITIONS

In re Application of
Vernon Wong and Lin Peng
Application No. 10/820,563
Patent No. 6,369,116
Filed: April 8, 2004
Attorney Docket No. D3136CONICIP RE
Title: COMPOSITION AND METHOD FOR
TREATING GLAUCOMA

DECISION ON PETITION

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed April 8, 2004.

On April 8, 2004, the reissue application was deposited, identifying Vernon Wong and Lin Peng as joint inventors. The application was deposited without a fully executed oath or declaration².

With the filing of the reissue application, Petitioner submitted the instant petition, the petition fee (which has been charged to Petitioner's Deposit Account, as authorized in the petition), and copies of various e-mails and letters.

The petitioner has met requirements (1), (3) and (5) above. Requirement (2) does not apply, as

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² Joint inventor Wong did not execute the declaration.

the petition was included on filing.

Regarding the fourth requirement, Petitioner has submitted a statement of facts which sets forth that at various times, an attorney by the name of Stephen Donovan spoke with the non-signing inventor³, mailed letters and copies of U.S. patent number 6,369,116 and the declaration to his residence. Mr. Donovan also sent e-mails to the non-signing inventor, including copies of the patent and the declaration as attachments.

This statement of facts shows that the non-signing inventor did not communicate his refusal to the declarant directly, but rather he learned of the refusal through an intermediary. Similarly, it was not the declarant who sent these items to the non-signing inventor.

Regarding the telephonic refusal, where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

Statements by a party not present when an express oral refusal was made will not be accepted.

Regarding the mailing of the patent to the non-signing inventor, the statement of facts will not suffice as evidence that a complete copy of the patent was sent to the non-signing inventor, as the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

Statements based on hearsay will not normally be accepted.

Put another way, where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

Furthermore, the petitioner has not established that the copies of the patent which were sent were complete copies, and one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁴.

For these reasons, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

³ The non-signing inventor allegedly told Mr. Donovan that he would not execute the declaration.

⁴ In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

On renewed petition, petitioner should submit a statement(s) from one having firsthand knowledge of the oral refusal and the mailings.

The renewed petition should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁵ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁶ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁷ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.